

Group X, including claim 28, drawn to a method for screening for an individual for a predisposition to a disorder in which DNA repair plays a role.

Applicants hereby elect to prosecute the claims of Group I, claims 1-6, 19, 22 and 25, with traverse. Applicants expressly reserve the right under 35 USC §121 to file a divisional application directed to the non-elected subject matter during the pendency of this application.

Remarks

This application was filed under 35 U.S.C §371 as a US national stage application under the Patent Cooperation Treaty. Restriction practice in such application is determined under unity of invention principles as set forth in 37 C.F.R 1.471 and 1.499. As a consequence, an application may only be properly required to be restricted to one or more of the claimed inventions if they are able to support separate patents and they are either independent or distinct.

Further, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even if it includes claims to indistinct or dependent inventions.

"Independent" is submitted to mean that there is not a disclosed relationship between the two or more subjects disclosed, this is, they are unconnected in design, operation or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

"Distinct" means that two or more subjects disclosed are related, for example as combination and part (sub-combination) thereof, process and apparatus for its practice, process and products made, etc., but are capable of separate manufacture, use or sale as claimed, and are patentable (novel and unobvious) over each other (though, of course, they may each be unpatentable because of the prior art). The term "related" is used as an alternative for dependent in referring to a subject other than independent subjects.

Thus for a restriction to be proper:

1. The inventions must be independent or distinct as claimed; and

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2. There must be a serious burden on the examiner, if restriction is required.

In the present case the Examiner has asserted that claims 20, 21, 23, 24, 26 and 27 are drawn to three separate inventions which are independent or distinct over both each other and claims 1-6, 19, 22 and 25.

Claims 20, 23 and 26 relate to methods which comprise the steps of the methods of claims 1 and 2, 3-5, and claim 6 respectively and provide the additional step of providing the compound obtained by the methods of these claims to a cell.

The present application teaches the interactions between particular components of the DNA repair pathway. These previously unknown interactions represent a novel and non-obvious feature of the present invention. It is therefore these interactions, as described in claims 1-6 which define the contribution made by the present invention over the prior art according to Rule 13 PCT and therefore provide the special technical feature which links the claims of groups I, VII, VIII and IX. It is not correct to read implied process steps into the claims and then to cite these implied process steps, which do not define the contribution made by the invention over the prior art, as being special technical features which lead to the restriction requirement.

Considering each of the criteria for determining restriction of claims, in turn.

1. Are the inventions of these claims independent or distinct?

- a. Independency

There is clearly a disclosed relationship between the methods of these claims groupings in that the claims grouping the II-IX comprise the same methods steps as the methods of group I with a single additional step. The methods of groups VII-IX are not usable without the methods steps of group I.

- b. Distinction

The criteria here is whether the claim groupings are capable of separate manufacture use or sale as claimed and are patentable over each other. The issue is therefore whether the methods of claim groups VII-IX are patentably distinct over the methods of group I.

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The methods of groups VII-IX relate to obtaining a compound with a particular biological activity and providing that compound to a cell. Methods for obtaining suitable compounds with biological activity are taught by the invention of group I. Having obtained a suitable compound, the provision of it to a cell requires only standard known techniques. The application of these standard techniques is not patentably distinct, i.e. novel and non-obvious over the teaching of how to identify and obtain a compound on the basis of its biological activity for such purposes.

Serious Burden on the Examiner.

Claim groups VII-IX relate to methods which involve obtaining a compound using a method according to the invention of group I and providing that compound to cells. The methods are therefore those of claim group I with an additional (limiting) step.

Restriction is only proper where the Examiner would be unduly burdened by searching numerous unrelated inventions or technologies. Thus the scope of the search for related inventions even though burdensome cannot justify restriction of the related claims.

In order to carry out a thorough search of claim group VII-IX, the novel and inventive aspects of the invention would need to be searched. Providing biologically active compounds to cells is already known, so the Examiner would need to search the subject matter of claim group I in order to determine any prior art relating to the technical features of the inventions of groups VII to IX.

In order to search claim groups VII-IX, the Examiner would be carrying out the same search as for the claims of group I. Thus no "serious burden" would be placed on the Examiner. We therefore request that the claims groups of VII-IX are examined along with the claims of group I.

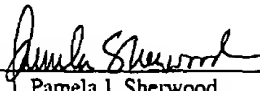
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The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815.

Respectfully submitted,
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Date: November 1, 2000

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